

REMARKS/ARGUMENTS

Claims 1-11, 13-26, 28-38, 40 and 42-50 remain in the application for further prosecution. The Applicants thank the Examiner for allowance of claims 42, 43 and 45-50.

§ 103 Rejections

Claims 1-3, 5-7, 10, 11, 16-18, 20-23, 25, 26, 28-30, 32-35, 37, 38 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,259,996 to Haun et al. ("Haun") in view of U.S. Patent Nos. 4,589,052 to Dougherty ("Dougherty") and 5,107,208 to Lee ("Lee '208"). As stated previously, independent claims 1 and 28 are directed to a system for determining whether arcing is present in an electrical circuit. Independent claim 16 is directed to a method for determining whether arcing is present in an electrical circuit. All three claims include the limitation that the system is contained on a single application specific integrated circuit chip (ASIC).

Also as stated previously, in order to prove a *prima facie* case of obviousness, the entirety of the prior art reference must be considered, including portions that teach away from the desirability of the combination. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). It is the Applicants' belief that both Dougherty and Lee '208 teach away from combining the circuit and the controller onto an ASIC.

Dougherty is directed to a digital trip unit for static trip circuit breakers implemented within a single integrated circuit chip. As stated by the Examiner, Dougherty states that the combination is not readily implemented within an ASIC (column 1, lines 53-55). Thus, one of ordinary skill in the art reading Dougherty would not be directed to make such a combination.

The same is also true of Lee '208. Lee '208 is directed to a system for partitioning and testing submodule circuits of an integrated circuit. Lee '208 states that the combination of digital and analog circuit modules on an ASIC requires an "undesirable amount of module layout area, as well as the necessity of running numerous additional wires from the multiplexer to various internal ports." Column 1, lines 65-68. Thus, Lee '208 also teaches away from the combination.

Therefore, it is the Applicants' belief that neither of these references are properly combinable with Haun because both teach away from the present invention.

Dependent Claims 4, 8, 9, 13-15, 19, 24, 31, 36, 40 And 44

The present Office Action continued to cite the following references against the dependent claims: U.S. Patent Nos. 4,792,899 to Miller ("Miller"), 5,774,555 to Lee et al. ("Lee '555"), 6,054,887 to Horie et al. ("Horie"), 5,784,020 to Inoue ("Inoue"), and 5,224,006 to MacKenzie et al. ("MacKenzie"). As stated in the previous response, none of these references address teaching away from the combination of Dougherty, Lee '208, and Haun that is discussed above. Thus, claims 4, 8, 9, 13-15, 19, 24, 31, 36, 40 and 44, which depend either directly or indirectly on independent claims 1, 16 or 28, are not obvious over Haun, Dougherty, Miller, Lee '208, Lee '555, Horie, Inoue, MacKenzie, Mann, or combinations thereof for at least the same reasons and, thus, should be allowable.

Conclusion

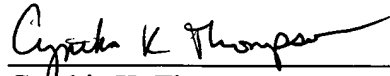
It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested.

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If there are any matters which may be resolved or clarified through a telephone interview,
the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

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